

VIA EFS

104825-0017-101

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Patrick Y. Lu et al.
Patent No. : 7,781,414
Application No. : 10/551,667
Confirmation No. : 5623
Filed : July 18, 2006
For : TARGETS FOR TUMOR GROWTH INHIBITION
Group Art Unit : 1635
Examiner : Tracy Ann Vivlemore

New York, New York
September 30, 2010

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Sir:

This responds to the Notice of Patent Term Adjustment ("Notice of PTA" hereinafter) indicated on the face of the subject patent, which issued from U.S. Patent Application No. 10/551,667 on August 24, 2010. The Notice of PTA sets forth a patent term adjustment ("PTA") of 378 days. Pursuant to 35 U.S.C. § 154(b)(3)(B)(ii) and 37 C.F.R. § 1.705(d), applicants request reconsideration of the PTA.

Pursuant to 37 C.F.R. § 1.705(d), this request must be filed within two months of the date the patent issued. Because the subject patent issued on August 24, 2010, this request is timely filed.

USPTO delay under 35 U.S.C. § 154(b)(1)(A) (“A delays”)

The subject application fulfilled the requirements of 35 U.S.C. § 371 on July 18, 2006 and the first notification under 35 U.S.C. § 132 was not mailed until September 19, 2007. The late mailing of the first § 132 notification delays issuance of a patent from the subject patent application by 1 day. 35 U.S.C. § 154(b)(1)(A)(i).

The issue fee was paid on December 30, 2009 and the patent issued on August 24, 2010. The late issuance of the patent creates a delay of 116 days. 35 U.S.C. § 154(b)(1)(A)(iv).

The above two periods of PTO delay under 35 U.S.C. § 154(b)(1)(A) (“A delays”) are conceded by the PTO, according to the PTA calculations on the Patent Application Information Retrieval system (PAIR). These three periods of A delays total 117 days, the same number of PTA days currently accorded by the PTO on PAIR.

USPTO delay under 35 U.S.C. § 154(b)(1)(B) (“B delays”)

PAIR records “B delays” of 690 days (noted as “PTA 36 months”). That number is incorrect. 35 U.S.C. § 154(b)(1)(B).

According to 37 C.F.R. § 1.703(b), the period of adjustment is the number of days in the period beginning on the day after the date that is three years after the date on which the national stage of the application commenced under 35 U.S.C. § 371(b) or (f) and ending on the date a patent was issued. The national stage of the subject application commenced under 35 U.S.C. § 371(b) on October 1, 2005. The three-year pendency deadline of the application was October 1, 2008. The patent issued on August 24, 2010. Under 37 C.F.R. § 1.703(b), this is a PTO delay of 692 days, calculated as the number of days in the period starting on October 2, 2008 and ending on August 24, 2010.

It is unclear to applicants how the PTO arrived at the 690 day number.

Applicant delay under 35 U.S.C. § 154(b)(2)(C)

Applicants filed on December 30, 2009 a Petition Re: Patent Term Adjustment. That Petition stated that applicants believed an additional 86 days of applicant delay should be accorded and calculated the total period of applicant delay under 37 C.F.R. § 1.704(c) as 303 days. On July 19, 2010, the PTO granted that Petition and stated that the PAIR screen had been updated to reflect that the correct PTA determination at the time of the mailing of the Notice of Allowance is 0 days, including 303 days of applicant delay. However, the copy of the updated PAIR screen attached to the Decision on the Petition shows that the PTO Delay Adjustment was entered incorrectly as -96 days (Exhibit A, page 3). This incorrect entry leads to an incorrect calculation of the total period of applicant delay as 313 days (217 + 96). Applicants request that the PTO Delay Adjustment be entered as -86 days, leading to a calculation of the total period of applicant delay as 303 days.

Determination of Patent Term Adjustment

As discussed above, the PTO delays in prosecuting the subject application include 117 days of delay under 35 U.S.C. § 154(b)(1)(A) and 692 days of delay under 35 U.S.C. § 154(b)(1)(B). The A delays and the B delays overlap by 116 calendar days from May 1, 2010 to August 24, 2010, as indicated on PAIR. 35 U.S.C. § 154(b)(2)(A) states:

To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Thus, under 35 U.S.C. § 154(b), applicants are entitled to a total PTA of 390 days (117 days plus 692 days, less the 116 overlapping calendar days and the 303 days of applicant delay). See also *Wyeth v. Kappos*, 591 F.3d 1364, 93 U.S.P.Q.2d 1257 (Fed. Cir. 2010).

Applicants state that the subject application is not subject to a terminal disclaimer.
37 C.F.R. § 1.705(b)(2)(iii).

This request for reconsideration does not raise issues that were raised, or could have been raised, in the December 30, 2009 Petition Re: Patent Term Adjustment under 37 C.F.R. § 1.705(b). Accordingly, the issues in this request are timely raised. 37 C.F.R. § 1.705(d).

Applicants hereby authorize the Director to charge the \$200.00 fee set forth in 37 C.F.R. § 1.18(e) and to charge any additional fee required, or credit any overpayment, in connection with this Application, to Deposit Account No. 06-1075, Order No. 104825-0017-101.

Respectfully submitted,

/Alla Brukman/

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OFFICE OF PETITIONS

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|----------------------------|------------------------------|
| In re Application | : |
| Lu, et al. | : |
| Application No. 10/551,667 | : DECISION ON APPLICATION |
| Filed: July 18, 2006 | : FOR PATENT TERM ADJUSTMENT |
| Docket No. 104825-0017-101 | : |

This is a decision on the "PETITION RE: PATENT TERM ADJUSTMENT", filed December 30, 2009. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) remain zero (0) days, but that eight-six (86) additional days of Applicant delay be accorded.

The application for patent term adjustment is GRANTED.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **zero (0) days, including three hundred three (303) days of Applicant delay**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On October 1, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date was zero (0) days.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment for PTO delay of one (1) day pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. §

1.703(a)(1), reduced by thirty-four (34), ninety-one (91), and ninety-two (92) days of applicant delay pursuant to 37 C.F.R. § 1.704(b).

However, Applicants point out that the ninety-one (91) days of Applicant delay should be ninety-two (92) days, as their October 28, 2008 response as reflected in PAIR was actually filed on October 29, 2009. A review of the application file in the Image File Wrapper reveals that Applicants are correct. Accordingly, ninety-two (92) days of Applicant delay pursuant to 37 CFR 1.704(b) should be assessed for this reply.


Furthermore, Applicants point out that they filed an IDS on April 16, 2008, after they had previously filed an Election on January 22, 2008. As such, pursuant to 37 CFR 1.704(c)(8), Applicants should have been assessed eighty-five (85) days for filing this supplemental paper.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **zero (0) days** (1 day of PTO delay, reduced by 303 (34+92+92+85) days of applicant delay).

The \$200 fee for filing the instant application for patent term adjustment under 37 CFR 1.705(b) has been charged to Deposit Account No. 06-1075, as authorized.

The application is being forwarded to the Office of Data Management for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.


Anthony Knight
Director
Office of Petitions

Enclosure: Copy of Revised PAIR Screen

PALM INTRANET

Day : Sunday
Date: 7/18/2010
Time: 11:44:09

| PTA Calculations for Application: 10/551667 | | | | | |
|---|--|------------|-------------------------|--|-----|
| Application Filing Date: | | 07/18/2006 | PTO Delay (PTO): | | 1 |
| Issue Date of Patent: | | | Three Years: | | 0 |
| Pre-Issue Petitions: | | 0 | Applicant Delay (APPL): | | 217 |
| Post-Issue Petitions: | | 0 | Total PTA (days): | | 0 |
| PTO Delay Adjustment: | | -96 | | | |

| File Contents History | | | | | |
|-----------------------|------------|--|-----|------|-------|
| Number | Date | Contents Description | PTO | APPL | START |
| 59 | 07/18/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 96 | |
| 49 | 10/01/2009 | MAIL NOTICE OF ALLOWANCE | | | |
| 48 | 09/30/2009 | ISSUE REVISION COMPLETED | | | |
| 47 | 09/30/2009 | DOCUMENT VERIFICATION | | | |
| 46 | 09/30/2009 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 45 | 09/30/2009 | NOTICE OF ALLOWABILITY | | | |
| 41 | 08/19/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 40 | 08/19/2009 | FEE PAYMENT RECORDED (FEES FILED SEPARATELY E.G. NOT WITH ORIGINAL PAPERS, ETC). | | | |
| 39 | 08/19/2009 | REFERENCE CAPTURE ON IDS | | | |
| 38 | 08/19/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 0 | 36 |
| 37 | 09/28/2009 | DATE FORWARDED TO EXAMINER | | | |
| 36 | 08/19/2009 | RESPONSE AFTER NON-FINAL ACTION | | 92 | 33 |
| 35 | 08/19/2009 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 34 | 08/19/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 33 | 02/19/2009 | MAIL NON-FINAL REJECTION | | | |
| 32 | 02/17/2009 | NON-FINAL REJECTION | | | |
| 31 | 10/28/2008 | NEW OR ADDITIONAL DRAWING FILED | | | |
| 30 | 12/07/2008 | DATE FORWARDED TO EXAMINER | | | |
| 29 | 10/28/2008 | RESPONSE AFTER NON-FINAL ACTION | | 91 | 26 |
| 28 | 10/28/2008 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
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|----|------------|--|---|----|----|
| 27 | 11/25/2008 | CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE | | | |
| 26 | 04/29/2008 | MAIL NON-FINAL REJECTION | | | |
| 25 | 04/28/2008 | NON-FINAL REJECTION | | | |
| 24 | 04/16/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 23 | 04/16/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 21 | 02/13/2008 | DATE FORWARDED TO EXAMINER | | | |
| 20 | 01/22/2008 | RESPONSE TO ELECTION / RESTRICTION FILED | | 34 | 15 |
| 19 | 01/22/2008 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 18 | 01/22/2008 | MISCELLANEOUS INCOMING LETTER | | | |
| 17 | 11/13/2007 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 16 | 11/10/2007 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 15 | 09/19/2007 | MAIL RESTRICTION REQUIREMENT | 1 | | 7 |
| 14 | 09/15/2007 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 13 | 02/16/2007 | MISCELLANEOUS INCOMING LETTER | | | |
| 12 | 01/04/2007 | PG-PUB ISSUE NOTIFICATION | | | |
| 11 | 11/06/2006 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 10 | 11/06/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 7 | 07/18/2006 | 371 COMPLETION DATE | | | |
| 6 | 09/01/2006 | APPLICATION DISPATCHED FROM OIPE | | | |
| 5 | 07/18/2006 | ADDITIONAL APPLICATION FILING FEES | | | |
| 4 | 07/18/2006 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |

Search Another: Application#

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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